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APPLICATION NO.	FILING DATE	STURZ	FIRST NAMED INVENTOR	K	ATTORNEY DOCKET NO.
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STAMFORD CT 06905-5619

GOLDBERG, J. J. EXAMINER

37 ART UNIT PAPER NUMBER

DATE MAILED: 07/07/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/077,180

Applicant(s)

Storz et al.

Examiner

Jonathan Goldberg

Group Art Unit

3731

☒ Responsive to communication(s) filed on Jul 16, 1998

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-19 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-4, 6, and 8-18 is/are rejected.

☒ Claim(s) 5, 7, and 19 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jul 16, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Objections*

1. Claim 6 is objected to because of the following informalities: The term “non-symmetrical” should be replaced by “asymmetrical”. Appropriate correction is required.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the drive unit accommodated in the hand piece of claim 2 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. The broken lines in Figure 3 do not suggest a motor.

In general, the drawings are replete with such problems where claimed features of several claims are not shown in the drawings. Applicant is advised to review the drawings in light of all claimed subject matter. No new matter should be entered.

3. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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5. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The specification fails to describe how one would specifically make the instrument such that the irrigation fluid is exhausted without entering the body cavity in accordance with the limitations of this claim.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. The term "non-symmetrical" in claim 6 is a relative term which renders the claim indefinite. The term "non-symmetrical" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Symmetry is a term used relative to an axis upon which the characteristic of symmetry can be determined. Without some reference axis, elements as claimed can be symmetrical and non-symmetrical simultaneously. The applicant should include some axis of reference against which one can judge symmetry.

8. Claim 14 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The element "a region" as claimed is too nebulous, ethereal and abstract to define an element.

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***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 8 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Henrie.

With regard to the claims, Henrie discloses an instrument with all the features as claimed.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Hocherl et al. Henrie discloses all the limitations of the claim except for a drive unit in the handpiece. Hocherl et al. teaches of a drive unit accommodated in the handpiece as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Hocherl et al. for convenience of ready operation without some assembly required.

12. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Thimsen et al. Henrie discloses all the limitations of the claim except for the stationary blade. Thimsen et al. teaches of a stationary blade provided outside the rotary blade as claimed. Hence,

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it would be obvious to employ the teaching of Thimsen et al. to afford the cutting end the combined ability to pierce into the surface and lacerate below the surface with one instrument.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Masch. Henrie discloses all the limitations of the claim except the non-symmetrical feature. Masch teaches of an irrigation passage with a non-symmetrical arrangement as claimed. Hence, it would be obvious to combine the teaching of Masch to avoid conflict with the positioning of other internal components. (Examiner notes the asymmetry is observed with respect to the longitudinal axis thus meeting the metes and bounds of the claim.)

14. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Merig Jr. Henrie discloses all the limitations of the claim except the detachably fastened handpiece. Merig Jr. teaches of a hollow shaft detachably connected to the handpiece as claimed. Hence, it would be obvious to employ the teaching of Merig Jr. to facilitate disassembly for cleaning purposes.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Itzkan. Henrie discloses all the limitations of the claim except the irrigation liquid being supplied and exhausted as claimed. Itzkan teaches of an irrigation liquid being supplied and exhausted as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Itzkan to soothe a wound with the cool tip of a surgical instrument (cooled by a fluid contained entirely within the instrument) while avoiding risk of contaminating the surgical site with the coolant liquid itself.

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16. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Sheridan et al. Henrie discloses all the limitations of the claim except the suction passage flared as claimed. Sheridan et al. teaches of a flared passage for suction as claimed. Hence, it would be obvious to employ the teaching of Sheridan et al. to permit proper sizing at the distal end to permit passage into a small incision while permitting the proximal end to accommodate a mating connection to a suction source of different size. This technique is commonly used in pipe routing for numerous purposes, including mating of different pipe sizes. In this instance, the device is better known in piping technology as an increaser, and it may be flared in concentric or eccentric design relative to its longitudinal axis.

17. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Thimsen et al. Henrie discloses all the limitations of the claim except the lateral cutting region and the oblique face of hollow shaft. The illustrations of Thimsen et al. teach of both a lateral cutting region and an oblique face as claimed. Hence, it would be obvious to employ the teaching of Thimsen et al. to utilize a blade designed as such to facilitate a deep cut, and to utilize an oblique face as such to provide a supplemental hand grip in addition to the hand piece.

18. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Itzkan. Henrie discloses all the limitations of the claim except the bulk volume discharged as claimed. Itzkan teaches of irrigation liquid being discharged in a region which does not serve for cutting as claimed. Hence, it would be obvious to employ the teaching of Banko to provide

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a collection area for disposal of exhausted irrigation fluid. Examiner notes the meaning of the term "discharge" is non-specific, and thus can be interpreted to mean egress of the irrigation fluid from either the supply or exhaust channel. Also, the phrase "in a region" is not necessarily directly associated with the instrument; it is interpreted broadly to mean a place anywhere.

19. Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie in view of Fogerty et al. Henrie discloses all the limitations of these claims except the proximal connectors adjacent each other. The illustrations of Fogerty et al. teach of proximal connectors adjacent each other as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Fogerty et al. to locate connections such as claimed by applicant to facilitate quick and simple and disconnection while conveniently located for the operator.

20. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie and Fogerty et al. in view of Frost. Henrie and Fogerty et al. disclose all the limitations of the claim except the connector angle of orientation. The illustrations of Frost teach of connectors oriented as claimed. Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Frost to accommodate the operator with a comfortable grip of the instrument when attaching hose lines to connectors.

21. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Henrie and Fogerty et al. in view of Banko. Henrie and Fogerty et al. disclose all the limitations of the claim except the irrigation passage ahead of the handpiece when viewed towards the proximal end. Illustration 22A of Banko teaches of the irrigation passage ahead in keeping with the claim.



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Hence, it would be obvious for one of ordinary skill in the art to employ the teaching of Banko to keep the handpiece free of a potential entanglement of tubes and (possibly) wires as well. The problem of tangled tubes and/or wires is more commonly referred to as a "rat's nest". This is well known to be a common potential problem whenever tubes and/or wires run in close proximity.

22. The courts have concluded that there is no requirement that a motivation to make the modification be expressly articulated by the prior art. The test for combining references is what the combination of disclosures takes as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). Also, references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

#### *Allowable Subject Matter*

23. Claims 5,7, and 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### *Conclusion*


24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kovalcheck discloses a tool with some features as claimed.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan (Jon) Goldberg whose telephone number is (703) 308-0161. The examiner can normally be reached Monday through Friday from 8:00 AM to 3:00 PM (ET).

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If attempts to reach the examiner by telephone are unsuccessful. The examiner's supervisor, Michael Buiz, can be reached at (703)308-0871. The Group FAX number is (703) 308-2708

Any inquiry of a general nature or relating to the status of the application should be directed to the Group receptionist at (703) 308-0858.

  
Jonathan D. Goldberg

6/30/99

MICHAEL BUIZ  
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